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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,379	11/15/2001	John Joseph Mascavage III	020375-002710US	2669

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,379

Applicant(s)

MASCAVAGE ET AL.

Examiner

Siegfried E. Chencinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. **FINALITY OF REJECTION:** Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of the last action is withdrawn.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 112 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application) in order to obtain the benefits of the filing dates of previously filed applications; the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant has claimed the filing date benefit of US patent Application No. 09/516,209 filed on February 29, 2000 as a continuation-in-part thereof. However, at least one limitation in independent claims 1, 10 and 17, “automatically opening a new web browser window for the customer”, does not appear to be in the claimed parent application’s disclosure. Thus, for this limitation, the earliest effective filing date should be the filing date of the instant application, i.e. November 15, 2001.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-15 & 17-20 are rejected under 35 U.S.C. 103(a) as being disclosed by Wilf et al (US Patent 5,899,980) in view of Fung (US PreGrant Publication 2002/0055909).

Re. Claims 1, 10 & 17, Wilf discloses a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

- receiving transaction information from the vendor site;
- presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window (The term "transaction detail" is an integral component Wilf's preferred term "transaction data" for approval by the customer/user. He uses this term throughout the reference. Examples are Col. 2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific definition to the effect that a "transaction amount" is a component of this "transaction detail" as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29).
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose automatically opening a new web browser window for the customer.

However, Fung et. al disclose "automatically opening a new web browser window for the customer" (page 4, [0056], lines 16-20). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf with that of Fung to establish an automated purchasing method which

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includes efficient automated web based steps for validating the payment for an online transaction without exposing the customer's personal information.

Re. Claims 2 & 18, Wilf discloses the method for authorizing the online purchase between the customer and the vendor site as recited in claim 1 & 17, wherein the new web browser window points away from the vendor site (Col. 2, lines 26-34).

Re. Claims 3 & 11, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Col. 2, lines 34-47).

Re. Claims 4 & 12, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, wherein the new web browser window overlays an existing web browser window of the vendor site (Col. 2, lines 3-5, 47-51).

Re. Claims 5, 13 & 19, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1, 10 & 17, wherein the receiving transaction information step triggers the automatically opening step (Col. 2, lines 3-15).

Re. Claims 6, 14 & 20, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1, 10 & 17, further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

Re. Claims 7 & 15, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claim 1 & 10, further comprising a step of presenting a message to the customer in the new web browser window indicating at least one of the following:

that authorization was canceled by the customer;

that authorization was rejected by a funds transfer system; and

that authorization completed normally (Col. 7, line 58 - Col. 9, line 20).

Re. Claim 9, Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and

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checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

4. Claims 8 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilf in view of Fung, and further in view of Kolling et al (US Patent 5,920,847).

Re. Claims 8 & 16, neither Wilf nor Fung explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claims 1 and 10, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, Kolling discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site as recited in claims 1 and 10, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf and Fung with the disclosure of Kolling to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction.

Response to Arguments

5. Applicant's arguments filed December 15, 2003 with respect to the pending claims have been considered and are moot in part due to the new grounds for rejection, and unpersuasive in regards to one argument, as elaborated on below.

a. APPLICANT'S ARGUMENTS:

(1) "For a valid anticipation rejection, the Office personnel must show that each and every limitation from the claims appears in a single piece of prior art" (page 7, lines 4-5).

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(2) Wilf et al. cannot be relied on to teach or suggest: (1) "automatically opening a new web browser for the customer" (Page 7, lines 7 – 9).

(3) Wilf et al. cannot be relied on to teach or suggest: "presenting a transaction amounts in the new web browser window." (Page 7, line 9).

b. EXAMINER'S RESPONSE

Re. Arguments (1) and (2): Applicant's arguments filed December 15, 2003 with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Re. Argument (3): Transaction amounts are not only an inherent, central component of Wilf's transaction details as referenced (Col. 2, line 66), but also an explicit component of Wilf's definition of a "transaction amount" as being a component of transaction detail to be presented to the customer/user for approval (Col. 9, lines 24-29).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703- 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington D.C. 20231

or faxed to:

(703)872-9306 [Official communications; including After Final communications
labeled "Box AF"]

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(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or
"DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive,
Arlington, VA, 7th floor receptionist.

SEC

January 8, 2004


HYUNG SOUH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600